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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,756	09/05/2003	Manjari Kuntimaddi	B02-67	9067

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EXAMINER	
BUTTNER, DAVID J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,756	KUNTIMADDI ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Such as 1,3 divinylbenzene" in claims 1 and 13 is unclear. Must Y be the subsequently named species or not?

Claim 2's structure does not appear to have a "Y" group as required by claim 1.

x, y and R are not defined in claim 2.

Claim 22 calls for a telechelic polyamine, yet claim 20 requires a telechelic polyol. A polyamine would make a polyurea rather than the polyurethane called for by claim 20.

Claims 20,21 and 23-25 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20,21 and 23-25 of copending Application No. 10-656704. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Dewanjee '268 or Yokota 2003/0114246 in view of Seneker '619.

Dewanjee and Yokota both disclose three layer golf balls having a urethane cover. The urethanes are made from a prepolymer of polyol and diisocyante (see Dewanjee's table 5; Yokota's table 3). The polyols are a polyetherpolyols (col 8 line 18 of Dewanjee; paragraph 17 of Yokota). Neither reference discloses the inherent polydispersity of the polyetherpolyols.

Seneker disclose narrow polydispersities of such polyols give prepolymers with low viscosities and easier processing/chain extension (col 3 line 35-47).

It would have been obvious to ensure the polydispersities of Dewanjee's and Yokota's polyetherpolyols are kept low in order to ease processing.

Claims 20 and 22-25 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rajagopalan 2004/0225100.

Rajagopalan suggests golf ball covers made from polyahl/isocyanate prepolymer (paragraph 42). The polyahl may be a diol or diamine (paragraph 10). The

polydispersity of the polyahly is under 2.1 (paragraph 41). The golf ball can include an intermediate layer (paragraph 89).

Claims 20 and 22-25 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rajagopalan 2004/0225102.

Rajagopalan suggests golf ball covers made from polyahl/isocyanate prepolymer (paragraph 42). The polyahl may be a diol or diamine (paragraph 10). The polydispersity of the polyahly is under 2.1 (paragraph 41). The golf ball can include an intermediate layer (paragraph 89).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20 and 22-25 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10-434739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application also claims golf ball covers of polyol/diisocyanate (eg claim 23). The ball may have an

intermediate layer (eg claims 19,27). Although not claimed, the polydispersity of the polyol is intended to be under 2.1 (paragraph 41).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 20 and 22-25 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10-434738. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application also claims golf ball covers of polyol/diisocyanate (eg claim 23). The ball may have an intermediate layer (eg claims 19,27). Although not claimed, the polydispersity of the polyol is intended to be under 2.1 (paragraph 41).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Schwindeman '681 discloses the the monodisperse telechelic polymer used by applicant. However, the reference does not suggest its reaction with diisocyanate. Furthermore, Schwindeman does not suggest golf ball uses. Wu 2003/0096936 shows polyurea based golf balls, but the diamines used to make the prepolymer in this reference are not based on dienes or styrenics. Wu also lacks any guidance on polydispersity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner

2/25/05